

**Kucab, Jamie R.**

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**From:** Butch, Peter J. [PButch@foxrothschild.com]  
**Sent:** Tuesday, February 01, 2011 2:29 PM  
**To:** Kucab, Jamie R.  
**Cc:** Fonseca, Perry M.  
**Subject:** 09/478,051; proposed claim amendment and issues to be discussed  
**Attachments:** Proposed\_Claim\_Amendments.doc

## Section 101

**The claims are directed to patentable subject matter as defined by the U.S. Supreme Court decision in *Bilski***

## Section 112/103

**There is adequate descriptive support in the inventors hand-written filings to obtain priority benefit of the application filed before Fleming**

### 2163.07(a) Inherent Function, Theory, or Advantage

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

### 2163.04 Burden on the Examiner with Regard to the Written Description Requirement [R-6]

The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

## Remarks

In the pending office action, the examiner stated that "computer-based" and "encoding a debit card" lacked support from the original filings.

The original filings provided "inherent" support for use of a computer in the claimed method:

1. From the Sept. '95 priority document (*italics* added):

"dollar amounts per day that are *charged* to the allowance card"

"supported by a major *credit card company*"

2. From the Jan. '96 filing:

"a card which is used in a similar manner as a credit card"

3. Additionally, the original filings describe a card with a "magnetic strip"

However, the present filing describes a card with a magnetic strip being used in ATM and debit/credit card processing systems. Such systems are described in various places, including wikipedia.com as employing a magnetic-strip reader connected to a computer programmed with appropriate software.

For example, from wikipedia for "magnetic strip":

"Magstripes following these specifications can typically be read by most point-of-sale hardware, which are simply general-purpose computers that can be programmed to perform specific tasks. Examples of cards adhering to these standards include ATM cards, bank cards (credit and debit cards including VISA and MasterCard), gift cards, loyalty cards, driver's licenses, telephone cards, membership cards, electronic benefit transfer cards (e.g. food stamps), and nearly any application in which value or secure information is *not* stored on the card itself. Many video game and amusement centers now use debit card systems based on magnetic stripe cards."

Thus, use of a card with a magnetic strip in a manner similar to a credit card inherently provides for use of point of sale hardware - computers programmed to perform specific tasks.

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